

## **REMARKS**

Claims 22-69 are pending in the Application and all have been rejected in the final Office action mailed March 25, 2010. No claims are amended by this response. Claims 22, 35, and 51 are independent claims from which claims 23-34 and 67, 36-50 and 68, and 52-66 and 69 depend, respectively. Applicants respectfully request reconsideration of pending claims 22-69, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office action sets forth "all reasons and bases" for rejecting the claims.

As previously noted, no claims are amended by this response. Therefore, this response cannot raise new issues that would necessitate a new search.

## Rejections of Claims

Claims 22, 25-28, 31, 32, and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy III, et al. (US 5,734,981, "Kennedy") in view of Sherif (US 5,459,722). Claims 23, 24, 29, and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, in further view of Henley, et al. (US 5,526,353, "Henley"). Claim 30 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif and Henley, and further in view of Sharman (US 5,774,854). Claims 35, 38-41, 44-47, 51, 54-57, and 60-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif. Claims 36, 37, 42, 43, 48, 49, 52, 53, 58, 59, 64, and 65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, and further in view of Henley. Claims 50 and 66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, and further in view of Sharman. Claims 67-69 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, and further in view of Bates, *et al.* (US 5,239,577, "Bates"). Applicants respectfully traverse the rejections.

Applicants respectfully note that all claim rejections are for alleged reasons of obviousness. Applicant now briefly reviews requirements for a rejection under 35 U.S.C. §103. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." (emphasis added) M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements;

instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP §2143.03. Further, “[**all words in a claim** must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” *Id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, all the words in a claim must be considered during the examination process.

#### **I. The Proposed Combination Of Kennedy And Sherif Does Not Render Claims 22, 25-28, 31, 32, 34 Unpatentable**

Claims 22, 25-28, 31, 32, and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif. Applicants respectfully traverse the rejection.

**With regard to independent claim 22**, Applicants respectfully submit that claim 22 recites, *inter alia*, “[a] device for communicatively coupling a packet network to at least one communication network having a different information format, the device comprising: ... at least one converter for selectively converting information received by the packet interface for transmission via one of the at least one network interface in the associated format, and for selectively converting for transmission via the packet interface information received from the one of the at least one network interface in the associated format” and “a controller for receiving, from either of the packet network and the at least one network interface, signaling information that initiates a call connection between the packet network and one of the at least one communication network, the

controller adapting the operation of the converter and establishing the call connection between the packet network and the one of the at least one communication network, based upon the received signaling information and a cross-reference between an address on the at least one communication network and an associated address on the packet network.” Independent claims 35 and 51 recite similar language. Applicants respectfully submit that the cited art does not teach, suggest, or disclose every aspect of Applicants’ claim 22, and that claim 22 is allowable over the cited art for a number of reasons

The Office action rejects claim 22 at pages 3-4, stating, in part:

Regarding claim 22, Kennedy, III et al teach a device (18, FIG. 1) for communicatively coupling a packet network (16, FIG. 1) to at least one communication network (38, FIG. 1) having a different information format, the device comprising: a packet interface (160, FIG. 3) for exchanging information via file [sic] packet network (column 4, lines 56-61); at least one network interface (170, 172, FIG. 3), each of the at least one network interface for exchanging information via an associated one of the at least one communication network in an associated format (column 11, lines 52-56); a controller (166, FIG. 3) for receiving call setup information (call delivery information) from one of the packet network (16, FIG. 1) and the at least one network interface (column 11, lines 33-35), the controller adapting the operation of a converter and establishing an association between the packet interface (160, FIG. 3) and one of the at least one network interface (170, FIG. 3), based upon the call setup information (column 11, lines 48-51, column 12, lines 50-54).

Initially, Applicants respectfully submit that the portion of the rejection shown above simply repeats much of the text from the prior rejection, and does not address the specific language recited by claim 22. See Office action of October 6, 2009 at pages 2-3. Applicants respectfully note that the language of claim 22 was amended in the response filed February 18, 2010, and that text from the present rejection of claim 22 does not reflect those changes. Therefore, because the Office has not even addressed

all of the features recited by claim 22 at the time of preparation of the instant Office action, it is not possible for the Office to establish a *prima facie* case of obviousness with respect to claim 22. As noted above, "[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP §2143.03. Further, "[**all**] words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." *Id.* Thus, claim 22 is allowable for at least this reason. Applicants respectfully submit that claim 22 is allowable for additional reasons.

The Office admits that Kennedy does not disclose certain aspects of claim 22, stating at pages 3-4:

Kennedy III et al. does not disclose at least one converter for selectively converting information received by the packet interface for transmission via one of the at least one network interface in the associated format, and for selectively converting for transmission via the packet interface information received from the one of the at least one network interface in the associated format; and a controller for receiving from either of the packet network and the at least one network interface, signaling information that initiates a call connection between the packet network and one of the at least one communication network, the controller adapting the operation of a converter and establishing the call connection between the packet network and the one of the at least one communication network, based upon the received signaling information and a cross-reference between an address on the at least one communication network and an associated address on the packet network.

Thus, the Office admits that Kennedy does not disclose Applicants' "converter" and "controller," as claimed. The rejection of claim 22, however, states that "Kennedy, III et al teach a device ... comprising ... a controller (166, FIG. 3) for receiving call setup information (call delivery information) from one of the packet network (16, FIG. 1) and the at least one network interface (column 11, lines 33-35), the controller adapting the

operation of a converter...." (emphasis added) Applicants respectfully note, however, that the Office has admitted that Kennedy does not teach "at least one converter...." Therefore, because Kennedy admittedly does not teach "at least one converter," as claimed, Applicants respectfully submit that Kennedy necessarily cannot teach, suggest, or disclose a "controller ... adapting the operation of the converter," as asserted by the Office. That is, because Kennedy does not teach a "converter," Kennedy also cannot teach a "controller" adapting the operation of a "converter" admittedly not taught by Kennedy. Therefore, it is not true that Kennedy teaches Applicants' "controller," as asserted by the Office.

In an effort to overcome the admitted deficiencies of Kennedy, the Office then turns to Sherif, stating at page 4:

Sherif teaches a converter (Fig. 1, 30 and 40) for selectively converting information received by a packet interface (Fig. 1, 70) for transmission via one network interface (Fig. 1, 10) in the associated format, and for selectively converting for transmission via the packet interface (Fig. 1, 70) information received from the one network interface (Fig. 1, 10) in the associated format; a controller (Fig. 6, 230) for receiving from either of the packet network and the at least one network interface, signaling information that initiates a call connection between the packet network and one of the at least one communication network, the controller adapting the operation of a converter and establishing the call connection between the packet network and the one of the at least one communication network, based upon the received signaling information and a cross-reference between an address on the at least one communication network and an associated address on the packet network (column 5, line 41-46)

Thus, the Office identifies a combination of ref. 30 ("DCME 30") and ref. 40 ("ATM to DCME interface 40") of FIG. 1 of Sherif as teaching Applicants' claimed "converter." In addition, the Office identifies ref. 230 ("DCME 230") of FIG. 6 of Sherif as teaching Applicants' claimed "controller." The Office also cites Sherif at col. 5, lines 41-46, which Applicants have reproduced below:

At the originating endpoint, DCME 230 converts each ATM formatted packet, with its specific VPI and VCI, directly into a corresponding packet stream with a data link connection identifier ("DLCI"), in the efficient wideband packetized G.764/T.312 format. At the terminating end, DCME 230 converts the wideband packetized G.764/T.312 signal into the ATM format with the necessary VPI and VCI.

The cited portion of Sheriff at col. 5, lines 41-46, reproduced above, simply teaches that when operating as an "originating endpoint," the "DCME 230" converts each "ATM formatted packet" to a corresponding "packet stream" in "G.764/T.312 format," and when operating as a "terminating endpoint," the "DCME 230" converts the "G.764/T.312" signal (packet stream) to "ATM format." Therefore, Applicants respectfully submit that the cited portion of Sheriff teaches that "DCME 230" is a converter of "ATM format" packets to/from a "G.764/T.312 format" packet stream. Applicants respectfully submit that Sheriff provides additional information about cited element "DCME 230" in the paragraph immediately before the cited portion of text shown above. Applicants respectfully submit that Sheriff at col. 5, lines 29-40 states the following:

FIG. 6 shows another illustrative example of an ATM WAN in accordance with the invention. In this illustrative example, the function of ATM-to-DCME interfaces 20 and 30 shown in FIG. 1 are incorporated into DCMEs 220 and 230, respectively, which provides for the direct conversion of ATM formatted packets from local ATM networks 260 and 270 into wideband formatted packets for transmission over PSTN 10. As above, for purposes of clarity in the discussion which follow, local ATM network and DCME 230 are deemed on the transmitting endpoint of the ATM WAN, while local ATM network 260 and DCME 220 are deemed on the terminating endpoint of the ATM WAN.

As can be seen above, Sheriff at col. 5, lines 29-40 teaches that "DCME 220" and "DCME 230" of FIG. 6 include the functionality of the "ATM-to-DCME interface 20" and "ATM-to-DCME interface 30" of FIG. 1. Applicants respectfully submit, however, that

the Office identified the combination of ref. 30 ("DCME 30") and ref. 40 ("ATM to DCME interface 40") of FIG. 1 of Sherif as teaching Applicants' claimed "converter," not the "controller" element of Applicants' claim 22. As is described by Sherif at col. 5, lines 29-40 and as further clarified by comparing FIG. 1 and FIG. 6 of Sherif, "DCME 230" of FIG. 6 includes the functionality of the combination of "ATM-to-DCME interface 40" and "DCME 30" of FIG. 1, while "DCME 220" of FIG. 6 includes the function of "ATM-to-DCME interface 50" and DCME 20" of FIG. 1. Therefore, Applicants respectfully submit that "DCME 230," which the Office identified as teaching Applicants' claimed "controller" teaches, at most, the functionality of the combination of "ATM-to-DCME interface 40" and "DCME 30" of FIG. 1, which the Office has identified as teaching Applicants' claimed "converter."

Therefore, Applicants respectfully submit that, even if Applicants were to agree that the combination of "ATM-to-DCME interface 40" and "DCME 30" taught Applicants' claimed "converter," **which Applicants do not**, the "DCME 230," which the Office identified as teaching Applicants' "controller," is further described by Sherif simply as a combination of the "ATM-to-DCME interface 40" and "DCME 30," which the Office asserted as teaching Applicants' "converter." Therefore, Applicants respectfully submit that the Office has not demonstrated that the "DCME 230" of Sherif teaches, suggests, or discloses, at least, Applicants' "controller," admittedly missing from Kennedy.

In addition, Applicants have been unable to find teachings in the cited portions of Sherif (i.e., ref. 230 of FIG. 6 and col. 5, lines 41-46) that teach, suggest, or disclose remaining aspects of claim 22 admittedly not taught by Kennedy. That is, Applicants have been unable to discern, and the Office has not explained, where in FIG. 6, col. 5, lines 41-46, or any other figure or portion of text Sherif teaches, suggests, or discloses, at least, "a controller for receiving, from either of the packet network and the at least one network interface, signaling information that initiates a call connection between the packet network and one of the at least one communication network." Further, the Office has not shown where Sherif teaches, suggests or discloses, at least, "the controller adapting the operation of the converter and establishing the call connection between the



packet network and the one of the at least one communication network, based upon the received signaling information and a cross-reference between an address on the at least one communication network and an associated address on the packet network.” Applicants respectfully submit that the Office has not shown how the cited portions of Sherif at FIG. 6, or col. 5, lines 41-46, or any other illustration or text from Sherif teach, suggest, or disclose, at least, “the controller adapting the operation of the converter,” or “a cross-reference between an address on the at least one communication network and an associated address on the packet network,” let alone “adapting the operation of the converter” based upon “a cross reference,” as more fully recited by claim 22.

Therefore, because Kennedy does not teach Applicants’ claimed “controller,” and Applicants’ have shown that the Office has not demonstrated that Sherif teaches Applicants’ claimed “controller,” Applicants respectfully submit that the Office has not shown that the combination of Kennedy and Sherif teaches, suggests, or discloses Applicants’ “controller,” as recited by claim 22. Applicants therefore respectfully submit that the Office has not established a *prima facie* case of obviousness, that claim 22 is not rendered unpatentable by the cited art, and that claim 22 is allowable over the proposed combination of Kennedy and Sherif for at least these reasons. Applicants respectfully submit that claim 22 is allowable for at least an additional reason, no less significant than those set forth above.

According to M.P.E.P. §2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” (emphasis added)

Applicants respectfully submit that the rejection of claim 22 fails to provide the “explicit analysis” required by M.P.E.P. §2142. Instead, the rejections are simply copies of portions of the claim text with citations to the art of record inserted.

As the Federal Circuit recently noted, “[i]f the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable

of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that ... claims are obvious." See *In re Vaidyanathan*, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

"[W]hile *KSR* relaxed some of the formalism of earlier decisions requiring a 'teaching, suggestion, or motivation' to combine prior art references, it did not remove the need to anchor the analysis in explanation of how a person of ordinary skill would select and apply the teachings of the references." See *id.* at page 17. Moreover,

*KSR* did not free the PTO's examination process from explaining its reasoning. In making an obviousness rejection, the examiner **should not rely on conclusory statements** that a particular feature of the invention would have been obvious or is well known. Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion. Generally, **the examiner cites prior art references to demonstrate the state of knowledge.**

*Id.* (emphasis added).

"[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some **concrete evidence in the record** in support of these findings." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

Applicants respectfully submit that the Office has failed to provide the "...clear explanations of all actions taken by the examiner during prosecution of an application," in violation of M.P.E.P. §707.07(f). The Office does not provide "clear articulation of the reason(s) why the claimed invention would have been obvious," and "anchor the analysis in explanation of how a person of ordinary skill would select and apply the teachings of the references." Indeed, the Office simply repeats text from Applicants' claims, and inserts citations to the cited art, without explaining the reasons why one of

ordinary skill in the relevant art would be drawn to the references and make the proposed combination, and how the proposed combination renders Applicants' claimed subject matter obvious.

Therefore, Applicants respectfully submit that the Office has not provided the "explicit analysis" required by M.P.E.P. §2142 in order to establish a *prima facie* case of obviousness, that a *prima facie* case of obviousness has not been established, and that claim 22 is allowable over the cited art for at least this additional reason.

**Applicants respectfully request a telephone conference with the Examiner and his/her supervisor, should the Examiner choose to maintain the rejection of claim 22.**

**With regard to dependent claim 25**, Applicants respectfully note that the rejection of the instant Office action is simply a verbatim copy of the two most recent prior rejections of claim 25. See Office action of January 29, 2009 at page 4 and Office action of October 6, 2009 at page 5. Applicants responded to the rejection of January 29, 2009 on April 28, 2009. The subsequent Office action mailed October 6, 2009 failed to respond to Applicants' arguments. See Office action of October 6, 2009 at pages 14-15. Applicants noted the failure of the Office to respond to Applicants' argument in the response filed February 18, 2010. The instant Office action once again fails to address the substance of Applicants' argument with regard to claim 25, in violation of M.P.E.P. §707.07(f) and 37 C.F.R. §1.104. Applicants will not repeat the response of April 28, 2009 again here, but hereby incorporate herein that response as though set forth in its entirety. **Applicants respectfully submit that the Office continues to ignore M.P.E.P. §707.07(f) and 37 C.F.R. §1.104, fails to address the substance of Applicants' traversal of the rejection of claim 25, and that claim 25 is allowable for at least that reason alone.**

**With regards to dependent claims 31, 32, and 34**, Applicants respectfully note that the rejections of the instant Office action are repeats of the rejections of claims 31, 32, and 34 that appeared in the Office action of January 29, 2009 and the Office action

of October 6, 2009. Applicants will not repeat the response again here, but hereby incorporate herein that response as though set forth in its entirety. Applicants respectfully submit that the Office yet to address the substance of Applicants' responses filed April 28, 2009, in spite of repeating the rejections, in violation of M.P.E.P. §707.07(f) and 37 C.F.R. §1.104. **Applicants respectfully submit that claims 31, 32, and 34 are allowable for at least that reason alone.**

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has not set forth a *prima facie* case of obviousness with respect to claim 22 or any claims that depend therefrom, that claims 22 and its dependent claims are not rendered unpatentable by the cited art, and that claims 22-34 and 67 are allowable over the proposed combination of Kennedy and Sherif. In addition, Applicants respectfully submit that claims 25, 31, 32, and 34 are independently allowable. Accordingly, Applicants respectfully request that the rejection of claims 22, 25-28, 31, 32, and 34 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

## **II. The Proposed Combination Of Kennedy, Sherif, And Henley Does Not Render Claims 23, 24, 29, And 33 Unpatentable**

Claims 23, 24, 29, and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, in further view of Henley. Applicants respectfully submit that claims 23, 24, 29, and 33 depend directly or indirectly from independent claim 22. Applicants respectfully submit that claim 22 is allowable over the proposed combination of references, in that the Office has not asserted that Henley remedies the deficiencies of Kennedy and Sherif, set forth above. Because claim 22 is allowable over the proposed combination of references, Applicants respectfully submit that claims 23, 24, 29, and 33 that depend therefrom are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 23, 24, 29, and 33 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **III. The Proposed Combination Of Kennedy, Sherif, Henley, And Sharman Does Not Render Claim 30 Unpatentable**

Claim 30 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif and Henley, and further in view of Sharman. Applicants respectfully submit that claim 30 depends indirectly from independent claim 22. Applicants respectfully submit that claim 22 is allowable over the proposed combination of art, in that the Office has not asserted that either or both of Henley and Sharman overcome the shortcomings of Kennedy and Sherif, as set forth above. Because claim 22 is allowable over the proposed combination of references, Applicants respectfully submit that claim 30 that depends therefrom is also allowable, for at least the same reasons. Applicants respectfully submit that claim 30 is allowable for at least an additional reason.

Applicants respectfully submit that the rejection of claim 30 continues to rely on only Sharman for subject matter admittedly missing from Kennedy, Sherif, and Henley that was also previously admitted to be missing from Kennedy and Henley. *Compare* Office action of March 25, 2010 at pages 9-10 and Office action of October 6, 2009 at pages 6-7. Applicants further respectfully submit that the present rejection of claim 30 makes the identical arguments citing the same portions of Sharman as the rejection of claim 30 in the Office action of October 6, 2009. Applicants previously addressed the alleged teachings of Sharman and the now repeated arguments of the Office in the response filed February 18, 2010, and will not repeat those arguments again here, but hereby incorporate that response here as though set forth in full.

Applicants respectfully submit that the Office action responds to Applicants' arguments of February 18, 2009 over the alleged teachings of Sharman by simply repeating the argument from the rejection of October 6, 2009. *Compare* rejection of claim 30 and Response to Arguments in Office action of March 25, 2010 at pages 9-10 and 18, respectively, and rejection of claim 30 in Office action of October 6, 2009 at pages 6-7.

Applicants respectfully submit that the Office, by simply repeating the arguments of the rejection of October 6, 2009 in the Response to Arguments, verbatim, **does not address the substance of Applicants' arguments of February 18, 2010, as required by M.P.E.P. §707.07(f)**. Applicants pointed out error in the arguments presented by the Office. See Response filed February 18, 2010 at pages 24-27. The instant Office action does not specifically address Applicants' points that show error on the part of the Office in the interpretation of the disclosure of Sharman. Instead, the Office merely responds by repeating the text of the rejection of October 6, 2009, in violation of M.P.E.P. §707.07(f) and 37 C.F.R. §1.104. Applicants must therefore assume that **the Office has no rebuttal to Applicants' arguments showing error in the interpretation of Sharman by the Office**, and respectfully submit that the subject matter of claim 30 is therefore allowable over the cited art.

**Applicants respectfully request a telephone conference with the Examiner and his/her supervisor, should the Examiner choose to maintain the rejection.**

As noted earlier, the Office relies only on Sharman to overcome the admitted deficiency of Kennedy, Sherif, and Henley. Applicants have shown that Sharman does not teach the subject matter admittedly missing from Kennedy, Sherif, and Henley. Further, the Office does not assert that Kennedy, Sherif, and Henley provide any support in this regard. Because Kennedy, Sherif, and Henley admittedly do not teach what is claimed, and Applicants have shown that Sharman does not teach the missing subject matter, Applicants respectfully submit that the Office has not shown that the proposed combination of Kennedy, Sherif, Henley, and Sharman teach or suggest all aspects of Applicants' claim 30, as required by M.P.E.P. §2142. Therefore, Applicants respectfully submit that the cited art does not render claim 30 unpatentable, and that claim 30 is independently allowable over Kennedy, Sherif, Henley, and Sharman for at least this additional reason

Therefore, Applicants respectfully request that the rejection of claim 30 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**IV. The Proposed Combination Of Kennedy And Sherif Does Not Render Claims 35, 38-41, 44-47, 51, 54-57, And 60-83 Unpatentable**

Claims 35, 38-41, 44-47, 51, 54-57, and 60-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif. Applicants respectfully traverse the rejection.

**With regard to independent claims 35 and 51**, Applicants respectfully note that claims 35 and 51 recite features similar to those of claim 22. The Office rejects claims 35 and 51 relying on the same arguments and disclosure of Sherif relied upon in the rejection of claim 22. Therefore, Applicants respectfully submit that claims 35 and 51, and any claims that depend therefrom, are allowable over the cited art for at least some of the reasons set forth above with respect to claim 22, and request that the rejection of claims 35 and 51, and claims 38-41, 44-47, 54-57, and 60-63, that depend therefrom, under 35 U.S.C. §103(a), be reconsidered and withdrawn.

**With regard to claims 38 and 54**, the Office asserts that "Kennedy, II et al teach the method of claim 35 wherein the information exchanged via the packet network comprises digitized voice information (column 9, lines 65-67, column 10, lines 1-4). Applicants respectfully note that the Office cites only Kennedy and only at col. 9, lines 65-67 and col. 10, lines 1-4. Applicants have previously addressed this repeated rejection of claims 38 and 54. See response filed April 28, 2009 at pages 36-37 and response filed February 18, 2010 at page 28. Applicants will not repeat the responses of April 28, 2009 and February 18, 2010 again here, but hereby incorporate Applicants' earlier filed arguments here as if set forth in full. **Applicants respectfully note that the instant Office action did not respond to Applicants' arguments filed on April 28, 2009 and February 18, 2010, and that claims 38 and 54 are allowable for at least that reason alone.**

**With regard to claims 41 and 57**, the Office asserts that "Kennedy, II et al teach the method of claim 35 wherein the at least one communication network is a second packet network (172, FIG. 3, column 11, lines 51-52)." Applicants respectfully note that

the Office cites only Kennedy and only at "element 172" of Fig. 3 and col. 11, lines 51-52. Applicants have previously addressed this repeated rejection of claims 41 and 57. See response filed April 28, 2009 at page 37 and response filed February 18, 2010 at pages 28-29. Applicants will not repeat the responses of April 28, 2009 and February 18, 2010, but hereby incorporate Applicants' earlier filed arguments here as if set forth in full. **Applicants respectfully note that the instant Office action did not respond to Applicants' arguments filed on April 28, 2009 and February 18, 2010, and that claims 41 and 57 are allowable for at least that reason alone.**

Therefore, Applicants believe that claims 35 and 51 are allowable over the proposed combination of Kennedy and Sherif, for at least the reasons set forth above. Because claims 36-50 and 68 and claims 52-66 and 69 depend, respectively, from allowable independent claims 35 and 51, Applicants respectfully submit that claims 36-50, 52-66, 68, and 69 are also allowable over the cited art, for at least the same reasons. Further, Applicants have shown that claims 38, 41, 54, and 57 are independently allowable over the cited art. Accordingly, Applicants respectfully request that the rejection of claims 35, 38-41, 44-47, 51, 54-57, and 60-63 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **V. The Proposed Combination Of Kennedy, Sherif, And Henley Does Not Render Claims 36, 37, 42, 43, 48, 49, 52, 53, 58, 59, 64, And 65 Unpatentable**

Claims 36, 37, 42, 43, 48, 49, 52, 53, 58, 59, 64, and 65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, and further in view of Henley. Claims 36, 37, 42, 43, 48, and 49 depend from independent claim 35, and claims 52, 53, 58, 59, 64, and 65 depend from independent claim 51. Applicants respectfully submit that claims 35 and 51 are allowable over the proposed combination of references, for at least the reason that Henley fails to remedy the shortcomings of Kennedy and Sherif, set forth above. Because claims 35 and 51 are allowable over the proposed combination of Kennedy, Sherif, and Henley, Applicants respectfully submit that claims 36, 37, 42, 43, 48, 49, 52, 53, 58, 59, 64, and 65 that depend therefrom are



also allowable over the cited art, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 36, 37, 42, 43, 48, 49, 52, 53, 58, 59, 64, and 65 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **VI. The Proposed Combination Of Kennedy, Sherif, And Sharman Does Not Render Claims 50 And 66 Unpatentable**

Claims 50 and 66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, and further in view of Sharman. Applicants respectfully note that claim 50 depends from independent claim 35, and claim 66 depends from independent claim 51. Applicants respectfully submit that claims 35 and 51 are allowable over the proposed combination of references, in that the Office has not asserted that Sharman remedies the shortcomings of Kennedy and Sherif, set forth above. Because claims 35 and 51 are allowable over the proposed combination of Kennedy, Sherif, and Sharman, Applicants respectfully submit that claims 50 and 66 that depend therefrom are also allowable over the cited art, for at least the same reasons. Applicants respectfully submit that claims 50 and 66 are allowable over the cited art for at least an additional reason.

Applicants respectfully submit that the rejection of claims 50 and 66 continues to rely on only Sharman for subject matter admittedly missing from Kennedy and Hemmady, and missing from Kennedy and Sherif. *Compare* Office action of March 25, 2010 at pages 16-17 and Office action of October 6, 2009 at pages 13-14. Applicants further respectfully submit that the present rejection of claims 50 and 66 makes the identical arguments citing the same portions of Sharman as the rejection of claims 50 and 66 in the Office action of October 6, 2009. Applicants previously addressed the alleged teachings of Sharman and the now repeated arguments of the Office, in the response filed February 18, 2010, and will not repeat those arguments again here, but hereby incorporate that response here as though set forth in full.

Applicants respectfully submit that the Office action responds to Applicants' arguments of February 18, 2009 over the alleged teachings of Sharman by simply

repeating the argument from the rejection of October 6, 2009. Compare rejection of claims 50 and 66 and Response to Arguments in Office action of March 25, 2010 at pages 16-17, and 18, respectively, and rejection of claims 50 and 66 in Office action of October 6, 2009 at pages 13-14.

Applicants respectfully submit that the Office, by simply repeating the arguments of the rejection of October 6, 2009 in the Response to Arguments, verbatim, **does not address the substance of Applicants' arguments of February 18, 2010 with regard to the alleged teachings of Sharman, as required by M.P.E.P. §707.07(f).** Applicants pointed out error in the arguments presented by the Office. See Response filed February 18, 2010 at pages 29-32. The instant Office action does not specifically address Applicants' points that show error on the part of the Office in the interpretation of the disclosure of Sharman. Instead, the Office merely responds by repeating the text of the rejection of October 6, 2009, in violation of M.P.E.P. §707.07(f) and 37 C.F.R. §1.104. Applicants must therefore assume that **the Office has no rebuttal to Applicants' arguments showing error in the interpretation of Sharman by the Office,** and respectfully submit that the subject matter of claims 50 and 66 are therefore allowable over the cited art.

**Applicants respectfully request a telephone conference with the Examiner and his/her supervisor, should the Examiner choose to maintain the rejection based on the alleged teachings of Sharman.**

As noted earlier, the Office relies only on Sharman to overcome the admitted deficiency of Kennedy and Sherif. Applicants have shown that Sharman does not teach the subject matter admittedly missing from Kennedy and Sherif. Further, the Office does not assert that Kennedy and Sherif provide any support in this regard. Because Kennedy and Sherif admittedly do not teach what is claimed, and Applicants have shown that Sharman also does not teach the missing subject matter, Applicants respectfully submit that the Office has not shown that the proposed combination of Kennedy, Sherif, and Sharman teach or suggest all aspects of Applicants' claims 50 and 66, as required by M.P.E.P. §2142. Therefore, Applicants respectfully submit that

the cited art does not render claims 50 and 66 unpatentable, and that claims 50 and 66 are independently allowable over Kennedy, Sherif, and Sharman for at least this additional reason.

Accordingly, Applicants respectfully request that the rejections of claims 50 and 66 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **VII. The Proposed Combination Of Kennedy, Sherif, And Bates Does Not Render Claims 67-69 Unpatentable**

Claims 67-69 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy in view of Sherif, and further in view of Bates. Applicants respectfully submit that claims 67, 68, and 69 depend, respectively, from independent claims 22, 35, and 51. Applicants respectfully submit that claims 22, 35, and 51 are allowable over the cited art, in that the Office has not asserted that Bates overcomes the deficiencies of Kennedy and Sherif set forth above. Because claims 22, 35, and 51 are allowable over the proposed combination of references, Applicants respectfully submit that claims 67, 68, and 69 that depend therefrom are also allowable over the cited art, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 67, 68, and 69 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

## Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

An early Office Action on the merits and allowance of claims 22-69 is respectfully requested.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: June 25, 2010  
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